REMARKS

This is in full and timely response to the Office Action mailed on November 2, 2004. Reexamination in light of the amendments and the following remarks is respectfully requested.

Claims 56 and 74-93 are currently pending in this application, with claims 56 and 74 being independent. No new matter has been added.

Entry of amendment

This amendment *prima facie* places the case in condition for allowance. Alternatively, it places this case in better condition for appeal. Accordingly, entry of this amendment is respectfully requested.

Prematureness

Applicant, seeking review of the *prematureness* of the final rejection within the Final Office action, respectfully requests reconsideration of the finality of the Office action for the reasons set forth hereinbelow. See M.P.E.P. §706.07(c).

Final Office Action not necessitated by amendment

The "second or any subsequent actions on the merits shall be final, ***except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment*** of the claims nor based on information submitted in an information disclosure statement" (*emphasis added*). M.P.E.P. §706.07(a).

The non-final Office Action mailed on July 27, 2004 includes the rejection of claims 51-58 under 35 U.S.C. §102 as allegedly being anticipated by Japanese Publication No. 11-

096948 to Kato Hiroshi et al. (Kato). No other rejection has been set forth within the non-final Office Action of July 27, 2004.

In response to the non-final Office Action mailed on July 27, 2004, the Amendment In Response To Non-Final Office Action filed on August 13, 2004 includes an amendment that places claims 56 and 57 into independent form. Thus, **no change in scope** of claims 56 and 57 is the result of this amendment.

But the Final Office Action of November 2, 2004 includes a new ground of rejection applied to claims 56 and 57 under 35 U.S.C. §102 as allegedly being anticipated by a newly cited reference, U.S. Patent 5,602,442 to Jeong. The use of Jeong in this manner is an introduction of a ***new ground of rejection*** *that was neither necessitated by applicant's amendment* of the claims nor based on information submitted in an information disclosure statement. Thus, the issuance of a Final Office Action at this time is *premature and improper* as a result.

In this regard, the use of Jeong in the rejection claims 56 and 57 should have occurred within the context of a ***non-final Office Action*** instead of occurring within the context of a Final Office Action.

Withdrawal of the Final Office Action is respectfully requested.

Rejection under 35 U.S.C. §102

Claims 51-73 were rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent 5,602,442 to Jeong.

This rejection is traversed at least for the following reasons.

While not conceding the propriety of these rejections, and in order to further the prosecution of the application, claims 51-55 and 57-73 have been canceled without prejudice or

disclaimer of their underlying subject matter, rendering this rejection moot as to claims 51-55 and 57-73.

In addition, the features of prior claim 62 have been wholly incorporated into claim 56 to form amended claim 56. Since prior claim 62 has been examined on the merits within the Final Office Action, *a new search and/or consideration is not believed to be required*.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Prior claim 62, presented herein as amended claim 56, is drawn to a flat cathode-ray tube comprising:

> a transfer foil having a fluorescent layer and a reflective layer, said reflective layer being between said fluorescent layer and a screen panel, the total surface area of said reflective layer being smaller than the total surface area of said fluorescent layer,
>
> wherein said transfer foil includes a grid layer between said reflective layer and said screen panel,
>
> wherein said transfer foil further includes an adhesive layer between said grid layer and said screen panel,
>
> wherein said grid layer, said reflective layer and said fluorescent layer is adhered to said screen panel through said the adhesive layer, and
>
> wherein a peripheral edge of said fluorescent layer extends beyond a peripheral edge of said reflective layer.

The Office Action contends that Jeong teaches a fluorescent layer 104, a reflective layer 103, a grid layer 102, and a screen panel 100. But within claim 56, the transfer foil further includes an adhesive layer between the grid layer and the screen panel.

Jeong fails to disclose, teach or suggest an adhesive layer between the grid layer 102 and the screen panel 100. Although figure 3D of Jeong shows the fluorescent layer 104 and the reflective layer 103, figure 3D of Jeong also shows the grid layer 102 in direct contact with the screen panel 100 while failing to show the presence of an adhesive layer.

In contrast, figure 5A of the specification as originally filed shows the presence of the fluorescent layer 14 and the reflective layer 13, the grid layer 12, the adhesive layer 24, and the screen panel 3. Yet, no adhesive layer is found within figure 3D of Jeong.

Please note that *the transfer foil further including an adhesive layer between the grid layer and the screen panel* as found within the claimed invention *is a structural feature and not a process step*. To account for the absence of an adhesive within figure 3D of Jeong, the Office Action opines that the adhesive layer is directed to an intermediate product and is therefore subject to a product-by-process limitation and is not afforded patentable weight.

In response, a "product-by-process" claim is one in which the product is defined at least in part in terms of the method or process by which it is made. *Atlantic Thermoplastics Co. Inc. v. Faytex Corp.* 23 USPQ2d 1481, 1488 (Fed. Cir. 1992). In this regard, the Office Action attempts to recast the structural feature of an adhesive layer as a process step. However, such a reconstruction is merely an attempt to redefine the invention in a manner different than from what is set forth within the claims. Such reconstruction is without authority under Title 35 U.S.C., Title 37 C.F.R., the M.P.E.P. and relevant case law; such reconstruction is therefore deemed improper and inappropriate.

Furthermore, all claim features *must* be considered. *Ex parte Petersen*, 228 USPQ 217, 218 (Bd. Pat. App. & Int. 1985). Exclusion of any claimed feature from consideration is also deemed improper and inappropriate. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)(Board erred by denying patentable weight to data structure limitations).

Withdrawal of this rejection and allowance of the claims is respectfully requested.

If the allowance of claim 56 is not forthcoming at the very least and a new grounds of rejection made, then a ***new non-final Office Action*** is respectfully requested.

Claims 56-58, 63-67 and 69-73 were rejected under 35 U.S.C. §102 as allegedly being anticipated by Japanese Publication No. 11-096948 to Kato Hiroshi et al. (Kato).

This rejection is traversed at least for the following reasons.

While not conceding the propriety of these rejections, and in order to further the prosecution of the application, claims 57-58, 63-67 and 69-73 have been canceled without prejudice or disclaimer of their underlying subject matter, rendering this rejection moot as to claims 57-58, 63-67 and 69-73.

In addition, no rejection using Kato has been applied to prior claim 62. Accordingly, while not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, the features of prior claim 62 have been wholly incorporated into claim 56 to form amended claim 56, rendering this rejection moot as to amended claim 56.

Withdrawal of this rejection is respectfully requested.

Newly added claims

Claim 74 is drawn to a flat cathode-ray tube comprising:

a transfer film; a transfer foil; and a screen panel, wherein:

said transfer foil has a fluorescent layer and a reflective layer,

said reflective layer is between said fluorescent layer and said screen panel, and

the adhesiveness of said transfer foil to said screen panel is stronger than the adhesiveness of said transfer foil to said transfer film.

Kato and Jeong, either individually or as a whole, fail to disclose, teach or suggest the adhesiveness of a transfer foil to a screen panel being stronger than the adhesiveness of the transfer foil to a transfer film. Allowance of the claims is respectfully requested.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: November 30, 2004

Respectfully submitted,

By_____
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Attachment: REPLACEMENT SHEET

AMENDMENT TO THE DRAWINGS

In accordance with U.S. Patent and Trademark Office practice, proposed drawing changes as a REPLACEMENT SHEET is attached, wherein Applicant proposes to amend the drawings in the above-identified application as follows:

Please amend Figure 5D by replacing "24" with -- 12 --.

No new matter has been added. Approval is earnestly requested.